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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,179	08/27/2001	Martin Adamczewski	Mo-6580/LeA 34,821	7071

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EXAMINER

PAK, MICHAEL D

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,179

Applicant(s)

ADAMCZEWSKI ET AL.

Examiner

Michael Pak

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-20 and 23²-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8-12,14-20,23,25,31 and 32 is/are rejected.
- 7) ☒ Claim(s) 7,13, 24, 26-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment filed September 29, 2005 has been entered. Claims 1, 5-20, and 23-29 are examined. Claims 2-4 and 21-22 have been canceled.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Applicant's arguments filed September 29, 2005, have been fully considered but they are not found persuasive.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 5-6, 8-12, 14-20, 23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims encompass the term "entire region ... which is homologous" which is confusing and unclear because it is not clear what is the metes and bounds of the term.

Art Unit: 1646

Applicants argue that Beukel et al. is not encompassed by the term of the claims yet the term is not defined in the specification. It is not clear whether one amino acid sequence identity which is substituted is sufficient because it is not clear whether the term homologous encompass regions which are identical or similar or can be mostly different. Homologous is a relative term which is not defined. Thus it is not clear what the entire region of an unclear homologous regions is.

Claim 25 recite the term "unmodified" which is confusing and unclear because the metes and bounds of the term is not clear. It is not clear when an acetylcholine receptor is unmodified because all the receptors are experimentally manipulated causing some modification.

5. Claims 1, 5-6, 8-12, 14-20, 23 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The claims encompass the term "entire region ... which is homologous" which is new matter because the specification does not disclose the subgeneric claim limitation. The original claim encompass the generic term "at least one amino acid in the region ..." but the specification does not disclose the "entire region ..." term which is subgeneric to the "entire region ..." term.

Claim Rejections - 35 USC § 102

6. Claims 1, 5-6, 8-12, 14-20, 23, 25 and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Beukel et al. (Pesticide Science, 1999).

Beukel et al. disclose chimeric receptor comprising rat alpha and Drosophila alpha subunit (page 1031) The receptor also contained chicken Beta 2 subunit (page 1031). Beukel et al. disclose the nucleic acid encoding the above receptors which is expressed in oocytes (page 1032). The chimeric DNA were subcloned into pcDNA3 which inherently also requires the host cell transformed (page 1032, first column, bottom). The chimeric receptor is activated by imidacloprid and some receptors are not including chicken receptors (page 1032, first column, third and fourth paragraph).

Claims encompass the term “entire region ... homologous to ...” which encompasses the subunit of Drosophila because the Drosophila sequence has regions of sequence similarity and identity to SEQ ID NO:1 and other AchR subunits of all other species.

Applicants argue that the sequence comparison show that van den Beukel does not disclose the same sequence claimed. However, the claims encompass generic receptor subunit which is encompassed by the van den Beukel because the term “entire region ... homologous to ...” encompasses the subunit of Drosophila because the Drosophila sequence has regions of sequence similarity and identity to SEQ ID NO:1 and other AchR subunits of all other species.

Art Unit: 1646

7. Claims 7, 13, 24, and 26-30 are allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0829.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Michael D. Pak

Michael Pak
Primary Patent Examiner
Art Unit 1646
7 January 2006